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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the application of: Tarr, et al.	Attorney Docket:	PAYS0001
Serial No. 10/748,968	Art Unit:	3623
Filed: 12/29/2003	Examiner:	Van Doren, Beth
Title : Automated Compensation Reports Using Online Surveys and Collaborative Filtering		

Dated: February 11, 2005

Mail Stop Non-Fee Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RESPONSE TO OFFICE ACTION

Sir:

This submission is responsive to the Office Action dated 10/19/2004, and is accompanied by a replacement set of claims.

RESPONSE

1. Claim Rejection Under 35 USC § 112

The Examiner requests a correction to Claim 26 to make it dependent on Claim 24. Applicant has amended Claim 22 as shown in the attached replacement claims, resolving the issue raised by the Examiner.

2. Claim Rejection Under 35 USC § 102

The Examiner rejects Claims 1-73, 76-94, and 96-110 as being anticipated by US patent application 2003/0145015 by Turnasella (hereinafter "Turnasella"). A quick review of the Turnasella patent reveals that the two concepts presented by Turnasella and in the subject application are significantly, *i.e.* patentably, different from each other. Turnasella takes a well-known surveying approach and implements it in his system. This is shown in a nutshell in paragraph [0006] that specifically discusses the fixed nature of the system, noting that "*The salary data from the contributing members of a survey group is processed in a predetermined fashion into surveys and access to the surveys is provided to the survey group via the Internet.*" By contrast, in accordance with the disclosed invention, a flexible approach is provided where the survey is tailored to a specific person taking the survey and where the survey presented is not a predetermined survey. Moreover, with the invention herein new affinity groups may be created automatically, and without any intervention, providing additional and previously unexpected groupings that yield meaningful results. By contrast Turnasella specifically notes that his invention provides for a "*...website enabling contributing members to store salary data relating to benchmarked job positions...*". Hence, again, Turnasella shows the limitations of the invention versus that of the subject application. Below, please find more specific reference to the comments made by the Examiner in this respect.

Claim 1. The Examiner states that Turnasella anticipates the method of Claim 1. Applicant respectfully submits that the Examiner is in error in his determination because at least the creation of a user profile is not discussed or provided for by

Tumasella. This difference between Tumasella and the claimed invention begins with a difference in the definition of what an affinity group is at the first place. Tumasella defines that *"A survey subgroup 175 consists of a number of companies which agree to contribute information to the database..."* (see paragraph [0054]). Hence, the database created according to Tumasella is directed towards specific companies and the way they prefer to be grouped. By contrast, there is no requirement for predetermined affinity groups in the claimed invention, and these may be created as a result of answers provided by users as they take the surveys.

At none of the paragraphs shown by the Examiner, and in fact, in the entirety of Tumasella is there any indication of a user profile being built and stored in a database. Rather, there is checking of a user to fit to predetermined information that is stored within the database.

The Examiner further refers to Figs. 17 and 18 of Tumasella that clearly indicate that the storing of a user profile in accordance with the claimed invention does not exist in Tumasella. Database 172 clearly contains company related information (marked as company 1 through company 4). There is no provision whatsoever within database 172, nor is such suggested in the description of Tumasella, that a user profile is ever kept in database 172. The Tumasella system, at the most, would allow certain provisions for human resource managers to submit predefined data to a database, and be able to share such information with other HR managers on a very rigid basis, hence significantly different from the claimed invention. Based on these differences, Claim 1 should be allowed.

Applicant has made a minor amendment to Claim 1 (see attached Replacement Claims) to clarify the way an affinity group is created.

Claims 2-29. Claims 2-29 are deemed allowable because they ultimately depend from allowable Claim 1 (see above).

Claim 30. The Examiner states that Tumasella anticipates the method as claimed in Claim 30. Applicant respectfully submits that the Examiner is in error in his determination because at least the creation of a user profile is not discussed or

provided for by Turnasella. Consider the difference in the definition of what an affinity group is at the first place. Turnasella defines that "A *survey subgroup 175 consists of a number of companies which agree to contribute information to the database...*" (see paragraph [0054]). Hence, the database created according to Turnasella is directed towards specific companies and the way they prefer to be grouped. By contrast, there is no requirement for predetermined affinity groups in the claimed invention, and these may be created as a result of answers provided by users as they take the surveys.

Clearly, at none of the paragraphs shown by the Examiner, and in fact, in the entirety of Turnasella is there any indication of a user profile being built and stored in a database. Rather, there is checking of a user to a fit of predetermined information that is stored within the database.

The Examiner further refers to Figs. 17 and 18 of Turnasella that clearly indicate that the storing of a user profile in accordance with the claimed invention does not exist in Turnasella. Database 172 contains company related information (marked as company 1 through company 4). There is no provision whatsoever within database 172, nor is such suggested in the description of Turnasella, that a user profile is ever kept in database 172. The Turnasella system, at the most, would allow certain provisions for human resource managers to provided predefined data to a database, and be able to share such information with other HR managers on a very rigid basis, hence significantly different from the claimed invention. Based on these differences, Claim 30 should be allowed.

Applicant has made a minor amendment to Claim 30 (see Replacement Claims herein) to clarify the way an affinity group is created.

Claim 31--62. Claims 31-62 are deemed allowable because they depend from allowable Claim 30 (see above).

Claim 63. The Examiner states that Turnasella anticipates the method as claimed in Claim 63. There is a severe restriction behind the use of the system shown by Turnasella, specifically as it is a rigid system, requiring *a priori* determination of groups

and subgroups (see for example paragraph 0048). At no point, once the Tumasella system has been loaded by a contributor, and groups and subgroups determined, is it capable of allowing a user accessing the system to generate or be exposed to a new affinity group, resulting from independent answers provided to survey questions. Tumasella directs the user into a predefined route and no new relationships, not present in advance, are possible in accordance with such prior art solution. Therefore, there is also no need to create a user profile because the information is provided to the user going through the survey on an *ad hoc* basis, and by that token, the contributor is only that, a company that provides its salary data in a structured and rigid manner. Its usage of the data is constrained to the way it was entered and the predetermined grouping made. Hence, Tumasella does not suggest, imply, or otherwise teach to the person skilled in the art the need to create a user profile, let alone storing such a profile, and no such indication is given even in the figures to which the Examiner refers. In fact, the figures suggest to the contrary.

Furthermore, groups and subgroups are not created in the way Examiner considers them to happen. In fact, Tumasella is quite explicit on how groups and subgroups are created and notes that *"... a company 165 may associate itself with a subgroup 175 (survey group) of all subscribers of the salary service provider 160. Thus, for example, company 1, company 2 and company 3 could form a subgroup 175 of, for example, textile manufacturers within the southern states."* (Paragraph [0048]). This clearly indicates that affinity groups are not created in Tumasella as defined in the claimed invention, where the affinity groups are generated as a result of particular correlations found as a result of a user, or users, answering questions. The creation of affinity groups is dynamic and not predetermined by a contributor providing upfront information to the system. Therefore, Claim 63 should be allowed.

Nonetheless, Applicant provides an amendment to Claim 63 (see attached Replacement Claims) to clarify the way an affinity group is create.

Claims 64-73 and 77-91. Claims 64-73 and 77-91 are deemed allowable because they depend from allowable Claim 63 (see above).

Claim 92. The Examiner states that Tumasella anticipates the method as claimed in

Claim 92. The Examiner dissects the portions believed to be taught by Tumasella, however erroneously and asserts that Tumasella teaches an affinity group, a user profile, the filtering of an answer by a user, and the ability to determine the next appropriate question to be presented to the user. None of this is supported by the material shown by the Examiner, and in fact neither by the entire Tumasella. Each item has been separately discussed in detail above and is not repeated here for time saving purposes but is equally applicable. Thus, this claim should be allowed.

Nonetheless, Applicant submits an amendment to Claim 92 (see the attached Replacement Claims) to clarify the way an affinity group is created.

Claims 93, 94, and 96-110. Claims 93, 94, and 96-110 are deemed allowable because they depend from allowable Claim 92 (see above).

3. Claim Rejection Under 35 USC § 103

Claims 74, 75, and 95. Claims 74, 75, and 95 are deemed allowable because they depend from allowable Claim 92 (see above).

In view of the foregoing, the application is deemed to be in allowable condition. Should the Examiner find it helpful, he is encouraged to contact Applicant's attorney, Michael A. Glenn, at (650)474-8400.

Respectfully Submitted,



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